

REMARKS

Applicant acknowledges with appreciation the Examiner withdrawing the Examiner's previous rejections in light of Applicant's arguments and Dr. Smith's signed declaration, which were filed May 23, 2008. Claims 1-10, 14-20, and 35-50 are pending. Claims 11-13 and 21-33 have been canceled and claim 34 is not entered. Claims 1-10 are withdrawn from examination. Applicant has amended claims 14, 35, 41 and 46, and as such, Applicant respectfully submits that the present invention is distinguishable over each of the prior art references cited by the Examiner, and in support presents the following arguments.

Additionally, Applicant notes that an element that was inadvertently previously included with new claim 41 (the target fluid comprising a hydrocarbon) in the previous response to office action has now been removed. This element unduly and unnecessarily limited the claim as it was not a point of distinction in view of the rejection based on *Kalota*. As such, Applicant has deleted this inadvertent addition and submits that claim 41 is still in condition for allowance in light of *Kalota* for the same reasons claim 35 was distinguishable.

Response to 35 U.S.C. § 102/§ 103 Rejection in Light of US Pat. No. 5,106,435 ("*Hudson*")

Applicant respectfully traverses the initial rejection of claims 35-36 and 39-40 under 35 U.S.C. §§ 102(b) and/or 103(a) by *Hudson*. *Hudson* teaches a method for minimizing surface carbide formation during box annealing of DQSK steels with an aqueous solution containing phosphate ions. Not only is *Hudson* in a completely different and disparate field of art as compared to the present invention, but independent claim 35 includes the limitation that the target fluid comprises a hydrophilic fluid. Even if adopting the Examiner's position that the water used in *Hudson* is comparable to the target fluid of the present invention, the current claims are still distinguishable over *Hudson*. However, since the target fluid of claim 35 includes a hydrophilic fluid and

Hudson teaches the use of water, *Hudson* is clearly missing this element. Moreover, in light of the Examiner's alternative § 103(a) rejection based off of *Hudson*, *Hudson*'s use of water as the required target fluid clearly teaches away from claim 35. As such, *Hudson* is missing/teaching away from the element of the target fluid comprising a hydrophilic fluid.

For the Examiner's convenience, Applicant notes that support for this amendment may be found in the specification as originally filed. For instance, paragraph [0018] states that "in a preferred embodiment, the carrier fluid is a separate hydrophilic fluid that is highly miscible with lubricating fluid, such as a motor oil." Furthermore, paragraph [0019] states that "[i]n certain circumstances, the carrier fluid is a quantity of a target fluid, such as the lubricating fluid. The target fluid is the fluid that is identified as the majority fluid that is intended to bring the phosphorus-containing solution into contact with the metal to be treated." Therefore, since the carrier fluid can be a hydrophilic fluid, and the carrier fluid and the target fluid can be one in the same, the specification provides ample support that the target fluid can include a hydrophilic fluid. In conclusion, *Hudson* does not teach each and every element of claim 35. As claims 36 and 39-40 depend from claim 35, Applicant respectfully requests the Examiner to withdraw the rejection based on *Hudson* and allow the aforementioned claims.

Response to 35 U.S.C. § 102(b) Rejection in Light of U.S. Patent No. 4,060,433 ("*Chunat*")

Claims 14-16, 20, 35-37, 41-42, and 46-47 have been initially rejected as being anticipated by *Chunat* under 35 U.S.C. § 102(b). In light of the amendments noted above, Applicant respectfully asserts that *Chunat* does not anticipate the above referenced claims. *Chunat* teaches the use of a foaming solution to be sprayed on the outer surface of a hanging or inclined metal component. However, independent claims 14, 15, 41, and 46 (from which all the other claims depend) recite that wherein the metal substrate comprises at least part of an engine with the

phosphorus-containing solution being operable to create a conversion surface under engine operating conditions. Applicant submits that a foaming solution is not suitable for use wherein the metal substrate comprises at least part of an engine, particularly under engine operating conditions. As such, Applicant respectfully submits that *Chunat* fails to teach each and every element of claims 14, 35, 41, and 46. As claims 15-16, 20, 36-37, 42 and 47 depend from these claims, respectively, and incorporate the same limitations; Applicant respectfully requests the Examiner to withdraw the rejection based off of *Chunat* and allow all of the aforementioned claims.

For the Examiner's convenience, Applicant notes that support for this amendment may be found in paragraph [0021] of the specification as originally filed with U.S. Provisional Patent Application Serial No. 60/443,995, which was incorporated by reference in its entirety. For instance, "[i]ts action under engine operating conditions is to create a surface layer on steel engine parts" (emphasis added).

Response to 35 U.S.C. § 103(a) Rejection in Light of U.S. Patent No. 4,060,433 ("*Chunat*")

Applicant submits that dependent claims 17, 38, 43 and 48 are now in condition for allowance for the same reasons identified in the preceding section. Claims 17, 38, 43 and 48 all incorporate the distinguishing characteristic that the metal substrate comprises at least part of an engine, and are therefore distinguishable on the same grounds as noted above. Therefore, Applicant respectfully requests the Examiner to withdraw the rejection based off of *Chunat* and allow the aforementioned claims.

Response to 35 U.S.C. § 103(a) Rejection in Light of U.S. Patent No. 5,106,435 ("*Hudson*")

For purposes of this response, Applicant assumes that the Examiner intended to make this § 103(a) rejection unpatentable over *Hudson* in light of *Chunat*, rather than merely *Hudson* as identified in the Office Action. Based on this assumption as to the basis of the rejection, Applicant submits that no person of ordinary skill in the art would look to combine these references as they are in completely unrelated fields. *Hudson* relates to box annealing while *Chunat* relates to coating metal surfaces with a foaming solution that is capable of having a sufficient contact time with a metal substrate. As such, Applicant respectfully submits that such combination of two unrelated references is improper, and therefore, respectfully requests the Examiner to withdraw the current rejection based upon the combination of these two references.

In addition to the comments above, Applicant respectfully submits that even in combination, *Hudson* and *Chunat* fail to teach or suggest each and every element of the present invention. For instance, independent claims 14, 35, 41 and 46 all require that wherein the metal substrate comprises at least part of an engine. As the foaming solution taught by *Chunat* would not be suitable for use with a metal substrate that comprises at least part of an engine under engine operating conditions, Applicant submits that claims 18-19, 39-40, 44-45, and 49-50, all of which incorporate the above referenced distinguishing feature, are distinguishable on the same grounds.

Furthermore, claims 39-40 depend from claim 35, which requires the target fluid comprise a hydrophilic fluid. As *Hudson* requires the use of water as its target fluid, Applicant submits that *Hudson* teaches away from claims 39-40. In light of the aforementioned arguments, Applicant respectfully requests the Examiner to place claims 18-19, 39-40, 44-45, and 49-50 in condition for allowance.

CONCLUSION

In commenting upon the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any implied limitations in the claims. Not all of the distinctions between the prior art and Applicant's present invention have been made by Applicant. For the foregoing reasons, Applicant reserves the right to submit additional evidence showing the distinctions between Applicant's invention to be unobvious in view of the prior art.

The foregoing remarks are intended to assist the Examiner in re-examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facets of the invention, which render it patentable, being only examples of certain advantageous features and differences that applicant's attorney chooses to mention at this time.

Reconsideration of the application and allowance of all of the claims are respectfully requested. In view of the foregoing Response, applicant respectfully submits that all of the claims are allowable, and Applicant respectfully requests the issuance of a Notice of Allowance. Should further discussion regarding the application be desired by the Examiner, a telephone conference is respectfully requested. I can be reached at (713) 221-3306. Applicant requests a Two-Month Extension of Time and the appropriate payment is included via electronic payment with a credit

card. The Commissioner is authorized to charge BRACEWELL & GIULIANI LLP, Deposit Account 50-0259 (27435.002) in the amount of any deficiency.

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Respectfully submitted,



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